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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,524	03/30/2004	Gary E. Sullivan	P1355US02	3293
32709	7590	05/01/2007	EXAMINER	
Gateway Inc Patent Attorney PO Box 2000 N. Sioux City, SD 57049			NGUYEN, CAO H	
			ART UNIT	PAPER NUMBER
			2173	
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			05/01/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/812,524

Applicant(s)

SULLIVAN, GARY E.

Examiner

Cao (Kevin) Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are rejected on the ground of nonstatutory double patenting over claims 1-21 of U. S. Patent No. 6,717,590 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: determining if said program is a recurring program from program information of said program, wherein a recurrence period information for said program is available when said program is a recurring program.

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Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See also MPEP § 804.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 6, 16 and 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1, 6, 16 and 21 are not tangible, useful or concrete. The preamble of independent claims 1, 6, 16 and 21 recite " A method, for a system using program scheduling information, said method comprising the steps of: receiving, retrieving, determining and enabling", which is directed to software, per se, lacking any hardware to enable any functionality to be realized. The claimed features and elements of independent claims 1, 6, 16 and 21 do not include hardware components or features that are necessarily implemented in hardware. Therefore, the claimed features of claims 1, 6, 16 and 21 are actually a software, or at best, directed to an arrangement of software, and software claimed by itself, without being executed or implemented on a computer medium, is intangible.

To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of the applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knee et al. US Patent No. (6,014,184) in view of Brown et al. (US Patent No. 6,026,368).

Regarding claims 1, 11 and 16, Knee discloses a method, for a system using program scheduling information, said method comprising the steps of receiving a selection of a program (see col. 6, lines 6-42); retrieving program information relating to said program; receiving a record command for said program; said record command including a recurrence period (see col. 12, lines 15-65); and enabling said record command when said recurrence period of said record command is similar to said recurrence period information of program information relating to said program (see col. 13, lines 6-60); however, Knee fails to explicitly teach determining if said program is a recurring program from program information of said program, wherein a recurrence period information for said program is available when said program is a recurring program.

Brown discloses determining if said program is a recurring program from program information of said program, wherein a recurrence period information for said program is

available when said program is a recurring program (see col. 12, lines 50-67 and col. 13, lines 1-27). It would have been obvious to one of ordinary skill in the art, having the teachings of Knee and Brown before him at the time the invention was made, to modify the electronic program schedule system of Knee to include recurring program information, as taught by Brown. One would have been motivated to make such a combination in order to provide the record function allows the user to record a program at a future date using the selected program's information contained within the program scheduling information.

Regarding claims 2 and 12, Brown discloses further comprising disabling said record command when said recurrence period of said record command is not similar to said recurrence period information of program information relating to said program (see col. 13, lines 7-67).

Regarding claims 3 and 13, Brown discloses further comprising notifying a user that said recurrence period of said record command is not similar to said recurrence period information of program information relating to said program (see col. 14, lines 14-67).

Regarding claims 4 and 14, Knee discloses wherein said recurrence period being at least one of daily, weekly, or monthly (see col. 18, lines 6-62).

Regarding claims 5 and 15, Brown discloses wherein said recurrence period is similar to said recurrence period information of program information relating to said program when both of said recurrence period and recurrence period information refer to a recurrence of at least one of daily, weekly or monthly (see col. 14, lines 1-58).

Claim 6 differs from claim 1 in that "receiving a request for a reminder for said program, said reminder providing a notice that said program will be broadcast, said reminder including a

recurrence period; determining if said program is a recurring program from program information of said program, wherein a recurrence period information for said program is available when said program is a recurring program” as recited in Knee (see col. 19, lines 5-61).

Regarding claims 7 and 17, Knee discloses further comprising disabling said reminder when said recurrence period of said reminder is not similar to said recurrence period information of program information relating to said program (see col. 20, lines 1-59).

Regarding claims 8 and 18, Knee discloses further comprising notifying a user that said recurrence period of said reminder is not similar to said recurrence period information of program information relating to said program (see col. 22, lines 28-67).

Regarding claims 9 and 19, Knee discloses wherein said recurrence period being at least one of daily, weekly, or monthly (see figures 37-38A).

Regarding claims 10 and 20, Knee discloses wherein said recurrence period is similar to said recurrence period information of program information relating to said program when both of said recurrence period and recurrence period information refer to a recurrence of at least one of daily, weekly or monthly (see col. 38, lines 18-63 and figures 43A-44).

Claim 21 differs from claims 1 and 11 in that “receiving a record command for said program; said record command including a recurrence period, said recurrence period being at least one of daily, weekly, or monthly; determining if said program is a recurring program from program information of said program, wherein a recurrence period information for said program is available when said program is a recurring program; enabling said record command when said recurrence period of said record command is similar to said recurrence period information of

program information relating to said program; disabling said record command when said recurrence period of said record command is not similar to said recurrence period information of program information relating to said program; and notifying a user that said recurrence period of said record command is not similar to said recurrence period information of program information relating to said program” as recited in Knee (see col. 43, lines 15-67 and col. 44, lines 3-63).

Conclusion

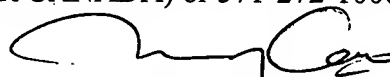
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see PTO-892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cao (Kevin) Nguyen whose telephone number is (571)272-4053. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeza can be reached on (571)272-4048. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Cao (Kevin) Nguyen
Primary Examiner
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04/27/07